

REMARKS

Prior to the outstanding Office action, claims 1-28 were pending in this application.

The Examiner has rejected claims 11-16 and 20-22 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2006/0023182 (Novak et al., hereafter “Novak”). In addition, the Examiner has rejected claims 1-10, 17-19 and 23-28 under 35 U.S.C. §103(a) as being unpatentable over Novak et al. (US 2006/0023182) in view of U.S. Patent Application Publication No. 2003/0123040 (Almogy, hereafter “Almogy”).

In this response, claims 5 and 26 are amended to correct minor typographical errors. With this amendment, claims 1-28 remain pending in this application.

Rejection of Claims 11-16 and 20-22 under 35 U.S.C. §102(e)

The Examiner has rejected claims 11-16 and 20-22 under 35 U.S.C. §102(e) as being anticipated by Novak et al. (US 2006/0023182).

Novak does not qualify as a reference against this application. This application was filed on October 3, 2003. The cited Novak reference was filed on September 28, 2005, nearly two years after this application. PAIR gives the 35 U.S.C. § 371(c) date as September 28, 2005. The cited reference is a continuation of International Application No. PCT/US04/09994, filed on April 1, 2004, seven months after this application. Neither the cited reference nor its parent International Application has an early enough filing date to qualify as prior art.

Unless the provisional applications from which the International Application claims benefit fully support the passages to which the Examiner refers, Novak does not qualify as prior art against this application. For purposes of analysis, the provisional applications are considered separately, because the earlier ‘112 provisional application does not include the later filed one and the later filed ‘033 provisional application did not incorporate and build on the text of the earlier filed one. Any parts of the International Application that mix-and-match disclosures from the two provisional applications would necessarily introduce new matter, as compared to either provisional application by itself, and would not be entitled to the benefit of either provisional filing date.

The earlier filed provisional application, 60/462,112, filed on April 10, 2003, is unrelated to the present application and discloses readily distinguishable technology.

The later filed provisional application, 60/485,033, filed on July 2, 2003 does not support the passages of the International Application or US continuation on which the Examiner relies. The Examiner relies on paragraph 0004, which describes “avoid[ing] the use of direct vacuum suction”, which is inconsistent with the ‘033 provisional, which teaches that “Channel C is continuously evacuated by the use of suction.” The Examiner relies on paragraphs 0024, 0026, 0027, 0036, 0045 and 0046, which describe a FIG. 1. However, the ‘033 provisional does not include FIG. 1 or any counterpart, so those paragraphs are not supported. The Examiner relies on paragraph 0035, which refers to several Laid Open applications and purports to incorporate them by reference. There is no corresponding passage in the ‘033 provisional, so this is new matter not entitled to the benefit of the provisional filing date. The Examiner also relies on paragraphs 0048, 0051 and 0063, which describe features of FIGS. 2B and 2C. The embodiment depicted in these figures and described in the paragraphs cited includes features that are not described in or supported by the ‘033 provisional. For instance, injector nozzles 258 and porous material in the transport region 256 are not disclosed in the ‘033 provisional. As the provisional does not include the embodiment described by these paragraphs and figures, the later filing date of the International Application is the date that applies. Finally, the Examiner relies on paragraph 0099, which refers to the flowchart in FIG. 6, which has no counterpart in the ‘033 provisional application. Since none of the paragraphs on which the Examiner relies have support in either of the provisional applications, the effective filing date of the Novak reference is April 1, 2004, seven months after the filing of this application.

Novak, therefore, does not qualify as a reference against this application.

Applicants respectfully request that the rejection of these claims under § 102(e) be withdrawn. As the case already has been the subject of a notice of appeal and no amendments are made in this paper (except for amendments to claims 5 and 26 to correct minor typographical errors), the claims should be allowed.

Rejection of Claims 1-10, 17-19 and 23-28 under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-10, 17-19 and 23-28 under 35 U.S.C. §103(a) as being unpatentable over Novak et al. (US 2006/0023182).

Novak does not qualify as a reference, for the reasons given above. The secondary reference does not include the features for which the Examiner relied on Novak. Applicants respectfully request that the rejection of these claims under § 102(e) be withdrawn. As the case already has been the subject of a notice of appeal and no amendments are made in this paper, the claims should be allowed.

CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims as now stated.

Applicants would welcome an interview, if the Examiner is so inclined. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Fee Authorization. The Commissioner is hereby authorized to charge any additional fee(s) determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (MLSE 1035-1).

Respectfully submitted,

Dated: 15 February 2007

/Ernest J. Beffel, Jr./
Ernest J. Beffel, Jr.
Registration No. 43,489

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
Telephone: (650) 712-0340
Facsimile: (650) 712-0263